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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,365	05/26/2000	Stephen Dao Hui Hsu	004828.P001	8126

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Dennis M De Guzman
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026

EXAMINER

TRAN, TONGOC

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/580,365	Applicant(s) HSU ET AL.	
	Examiner Tongoc Tran	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to Applicant's Request for Continued Examination filed on 11/8/2004. Claims 1-36 are canceled. New claims 37-69 are added. Claims 37-69 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 37, 48, 52, 55, 60 and 65 are provisionally rejected under the judicially created doctrine of double patenting over claims 1, 18, 27, 31 and 33 of copending Application No. 09/792,226. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-43 and 45-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subramaniam et al. (U.S. Patent No. 6,081,900) in view of Farah ("Encrypted Hypertext Transfer Protocol—UGGC/1.0", April, 2000, Network Working Group", pages 1-5).

In respect to claims 37, 51 and 55, Subramaniam discloses a method comprising:

receiving from a terminal or an intermediate unit a first request including a composite address the composite address including an address of a secure server with an address of a web page concatenated thereto (see col. 7, lines 1-58 and col. 8, lines 13-30 and col. 9, lines 18-47);

transmitting a second request to a web site containing the web page; retrieving the web page designated in the second request; modifying an address associated with the retrieved web page so that the secure server appears to be the source of the web page; sending web page to the terminal (see col. 7, lines 1-58 and col. 8, lines 13-30 and col. 9, lines 18-47);

Subramaniam does not teach but Farah teaches encrypting request web page address; altering address of the terminal and encrypting the content of the retrieved web page (see Farah, pages 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the encryption of user address and web page address and content taught by Farah with the teaching of secure access to web site resource taught by Subramaniam to prevent Internet spying (see Farah, page 1, Introduction).

In respect to claim 38, Subramaniam and Farah disclose the method of claim 37 wherein the secure link comprises a secure sockets layer (SSL) link (see col. 3, lines 20-25).

In respect to claim 39, Subramaniam and Farah disclose the method of claim 37 wherein modifying the address associated with the retrieved web page comprises modifying a Uniform Resource Locator (URL) or Internet Protocol (IP) address of the web site (see col. 3, lines 17-18 and col. 7, lines 1-20).

In respect to claim 40, Subramaniam and Farah disclose the method of claim 37 wherein modifying the address associated with the retrieved web page comprises

modifying an address associated with a hypertext link in the retrieved web page to indicate the address associated with the secure server (see col. 7, lines 1-20).

In respect to claim 41, Subramaniam and Farah disclose the method of claim 37, further comprising modifying computer code associated with the retrieved web page to cause subsequent requests related to the retrieved web page to be sent by the terminal to the secure server instead of to the web site (see col. 19, lines 48-56).

In respect to claim 42, Subramaniam and Farah disclose the method of claim 37, further comprising decrypting the encrypted address of the web page (see Farah, pages 1-5).

In respect to claim 43, Subramaniam and Farah disclose the method of claim 37, further comprising repeating the retrieving, modifying, encrypting, and sending while the secure link is active (see col. 6, line 60-col. 7, line 20).

In respect to claim 45, Subramaniam and Farah disclose the method of claim 37, further comprising, at the secure server, controlling transmission of electronic files to the terminal based on preferences received from the terminal (see col. 6, lines 40-60).

In respect to claim 46, Subramaniam and Farah disclose the method of claim 37, further comprising storing under a pseudonym at a location communicatively coupled to the secure server, electronic files sent with the web page (see Fig. 1, item 110, col. 9, lines 32-47 and col. 10, lines 10-15).

In respect to claim 47, Subramaniam and Farah disclose the method of claim 37, further comprising:

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obtaining information related to a user's communication with the secure server (see 8, lines 40-46);

Subramaniam and Farah do not disclose providing the obtained information to an entity based on permission of the user and in exchange for providing the secure link; and providing advertisements from the entity to the user related to the obtained information. However, profiling Internet user to provide advertising service is old and well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Subramaniam's providing user access to resource with user profiling for marketing purposes.

In respect to claims 48-50, the claimed limitations are machine-readable medium that are substantially similar to claims 37-39. Therefore, claims 48-50 are rejected based on the similar rationale.

In respect to claims 52-54, the claimed limitations are apparatus claims that are substantially similar to method claims 1, 38 and 46. Therefore, claims 52-54 are rejected based on the similar rationale.

In respect to claim 56, Subramaniam discloses the method of claim 55, further comprising receiving, at the secure server, communication protocol information related to a communication between the terminal and the intermediate unit, to allow the secure server to respond to requests sent to the intermediate unit from the terminal (see col. 18, lines 14-30).

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In respect to claim 57, Subramaniam discloses the method of claim 55 further comprising receiving subsequent requests from the terminal at the intermediate unit rather than directly at the secure server from the terminal (see col. 8, lines 24-30).

In respect to claims 58-59, the claim limitations are similar to claim 42. Therefore, claim 58 is rejected based on the similar rationale.

In respect to claims 60-69, the claim limitations are machine-readable medium and apparatus claims that are substantially similar to method claims 55-59. Therefore, claims 60-69 are rejected based on the similar rationale.

4. Claim 44 rejected under 35 U.S.C. 103(a) as being unpatentable over Subramaniam et al. (U.S. Patent No. 6,081,900) in view of Farah ("Network Working Group", April, 2000) and further in view of Gampper et al. (U.S. Patent No. 6,502,106).

In respect to claim 44, Subramaniam and Farah disclose the method of claim 37. Subramaniam and Farah do not disclose triggering a deletion of stored electronic files at the terminal related to a communication via the secure link, in response to termination of the communication between the terminal and the secure server.

However, Gampper discloses continuously delete files in a local cache (see col. 1, lines 64-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the continuously deletion of storage taught by Gampper to make room for recent retrieved web pages (Gampper, col. 1, lines 64-67).

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran
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TT

January 18, 2005

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100